

## REMARKS

1. Applicant thanks the Office for its remarks and observations, which have greatly assisted Applicant in responding.

### 2. OBJECTIONS TO THE CLAIMS

Claims 1, 2 and 16 are objected to because the expression "metadata fields" is alleged to be a typographical error. The Claims are amended as requested. The present objection is therefore deemed overcome.

### 3. 35 U.S.C. § 103

Claims 1-2 and 16-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent no. 6,915,299 ("Arcuri") in view of U.S. patent no. 6,775,537 ("Panichkul").

Claim 1: Claim 1 describes:

"A matter-centric document management system (DMS) comprising:

a processor programmed for setting up a matter file including a plurality of folders, each folder corresponding to a document type;

a processor programmed for automatically creating metadata data fields for a new document, when the new document is placed in a folder, the metadata data fields appropriate for the document type; and

a processor programmed for searching said matter file, wherein user-formulated queries are saved to said matter file, wherein said saved queries are browse-able and can be re-run at a user's option by selecting a query and wherein saved queries are associate-able with documents and folders."

Applicant first notes the Office's cryptic remark in the first full paragraph of page 5 of the Office Action "'wherein saved queries are associable with documents and folders' as properties are associated with documents and folders. Properties are not

saved queries." The comment is then followed by a citation to Arcuri, col. 1, lines 60-67. The cited portion of Arcuri has nothing to do with saved queries or associating one or more saved queries with documents and folders. The cited portion of Arcuri merely provides a general description of a document library as disclosed by Arcuri.

Applicant has searched the record and can find no basis for the Office's remark that saved queries are associable with documents and folders in the same manner as properties are associated with documents and folders. The original Application contains no such statement in the specification or in the Claims. Applicant has not made such statement during prosecution of the Application. In fact, the comment appears to be the Office's admission that Arcuri does not teach or suggest the claim element.

If the Office is somehow trying to demonstrate that it would be obvious to the ordinarily-skilled practitioner to modify Arcuri in order to associate queries with documents or folders, Applicant notes that the combination is completely silent on the topic of associating queries with documents and folders. While Arcuri does teach associating attributes with documents and/or folders, it is incorrect that the ordinarily-skilled practitioner would be led by this practice to associating saved queries with documents and folders. The ordinarily-skilled practitioner would readily recognize that associating attributes with a document or folder is a simple act of assigning metadata. As shown in Fig. 4 of Arcuri, the user simply fills in a form to assign metadata to a document. There is nothing in the simple act of assigning metadata by filling out a form that would suggest to the ordinarily-skilled practitioner that he or she associate a saved query with a document or a folder. Panichkul has nothing additional to say on the matter.

Thus, the combination is free of any teaching or suggestion to associate saved queries with files or folders. The teaching therefore comes only from Applicant's own disclosure and Claims, an improper use of hindsight. "Any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from Applicant's disclosure, such a reconstruction is proper." MPEP § 2145 quoting *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971) (emphasis

added). Here, as Applicant has demonstrated, the teaching to associate saved queries with documents and folders was gleaned only from Applicant's own disclosure. Accordingly, the Office has improperly relied on a hindsight construction in formulating the present rejection.

Additionally, the Office has failed to explain why such modification would be obvious to the ordinarily skilled practitioner or why the ordinarily-skilled practitioner would be motivated to make the modification.

Furthermore, because the combination is completely silent on the topic of saved queries and associating queries with documents and folders, the combination provides no enablement to the ordinarily-skilled practitioner to associate queries with documents and folders. As Applicant demonstrated above, it is incorrect that a teaching of associating attributes with documents and folders would enable the ordinarily-skilled practitioner to associate a saved query with a document or a folder.

Additionally, the Office's failure to provide documentary evidence that teaches or suggests associating a saved query with a document or folder is a convincing demonstration that the subject matter of Claim 1 was unknown at the time of invention.

Accordingly, there is no teaching or suggestion in the combination of:

"A matter-centric document management system (DMS) comprising:  
a processor programmed for setting up a matter file including a plurality of folders, each folder corresponding to a document type;  
a processor programmed for automatically creating metadata data fields for a new document, when the new document is placed in a folder, the metadata data fields appropriate for the document type; and  
a processor programmed for searching said matter file, wherein user-formulated queries are saved to said matter file, wherein said saved queries are browse-able and can be re-run at a user's option by selecting a query and wherein saved queries are associate-able with documents and folders."

Because the combination fails to teach or suggest all elements of the Claimed subject matter, the present rejection is deemed improper. Claim 1 is therefore allowable over the combination.

In view of their dependence from an allowable parent Claim, Claims 2-15 are deemed allowable without any separate consideration of their merits. The foregoing remarks are equally applicable to Claim 16. Claim 16 is therefore allowable for the same reasons that Claim 1 is allowable. In view of their dependence from an allowable parent Claim, Claims 18-19 are deemed allowable without any separate consideration of their merits.

Applicant hereby incorporates its previous remarks regarding the cited secondary references as if fully set forth herein. Even if the priority of the subject Application had not been corrected, the foregoing rejections would be improper for reasons that Applicant has already discussed in detail in previous responses.

4. No new matter is added by way of the present amendments. Such amendments are made only in the interest of advancing prosecution of the Application, in recognition of the Office policy of compact prosecution. They do not signify agreement by Applicant with the Office's position. Nor do they reflect intent to forsake claim scope. In fact, Applicant expressly reserves the right to pursue patent protection of a scope it reasonably believes it is entitled to in one or more future filings with the Office.

5. For the record, Applicant respectfully traverses any and all factual assertions in the file that are not supported by documentary evidence. Such include assertions based on findings of inherency, assertions based on official notice, and any other assertions of what is well known or commonly known in the prior art.

## CONCLUSION

Based on the foregoing, the Application is deemed to be in allowable condition. As such, Applicant earnestly requests reconsideration and prompt allowance of the claims. Should the Examiner deem it helpful, the Examiner is invited to contact Applicant's attorney at 650-474-8400.

Respectfully submitted,

A handwritten signature in black ink, consisting of a stylized 'M' followed by a horizontal line.

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